



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

ch

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/659,955	09/12/2000	Steven G. Lemay	3735-932	6102

7590

07/18/2003

GEORGE H. GERSTMAN  
SEYFARTH SHAW FAIRWEATHER & GERALDSON  
55 EAST MONROE STREET  
42nd FLOOR  
CHICAGO, IL 60603-5803

EXAMINER

BROCKETTI, JULIE K

ART UNIT	PAPER NUMBER
----------	--------------

3713

DATE MAILED: 07/18/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/659,955

Applicant(s)

LEMAY ET AL.

Examiner

Julie K Brockett

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 6-26-03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 21-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) g.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-19 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. in view of Van Huben et al., U.S. Patent No. 5,878,408. Walker et al. discloses a game apparatus for configuring a payable for a gaming terminal. A microprocessor is used to control game play on the gaming terminal (Fig. 1). An input device is coupled to the microprocessor and receives information from a user for defining at least a part of a first payable (Fig. 3). The microprocessor is programmed to calculate an overall payout ratio for the payable (col. 7 lines 33-44). An output device such as a display is controlled to output information related to the results of the calculating (Fig. 8). The microprocessor is programmed to store the first payable in a memory coupled to the microprocessor (col. 3 lines 50-59). The input device can be a touch screen device (col. 2 lines 34-35). The display shows information <sup>from</sup> a stored payable, i.e. the default payable. The information in the stored payable can be modified to define a customized payable, i.e. first payable.

The information defines the magnitude of a monetary prize. When a player customizes the magnitude of a monetary prize the player is not allowed to modify or change the prize win frequency. Consequently, when one parameter is altered, the gaming system compensates by the computer modifying another parameter. Moreover, the microprocessor is programmed to calculate all possible game outcomes and any prizes associated with each possible game outcome. Thus every customization results are compared with predetermined gaming criteria to determine the final gaming parameters (col. 6 lines 57-67; col. 7 lines 1-12). Walker lacks in specifically stating that a message is output if the results fail to comply with the gaming criteria. Huben et al. teaches of a data management system and process. In the process a criteria check is performed and any data that does not pass the criteria check fails and a message is sent to the user (See Van Huben et al. col. 51 lines 29-37). It is well known throughout the art to perform criteria checks to determine if data falls within an acceptable range. It would have been obvious at the time the invention was made to compare the customized payable results to predetermined gaming criteria and then output a message to the user if the results fail to comply with the criteria. It is also obvious to suggest a modification to the payable when the results fail to comply with the criteria. For example, in Walker et al. after a user customizes a parameter, calculations to determine all other parameters are performed and the user must approve the new parameters before use. Consequently, if a user inputs an invalid

Art Unit: 3713

parameter, the calculation section will modify this parameter with a new suggested limit.

Claims 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. in view of "Regulation 14" of the Nevada Gaming Statutes. Walker discloses inputting information into a gaming terminal indicative of a payable change. It is inherent to the game that the newly customized payable is prevented from being used until all calculations are performed, thereby gaining regulatory approval and user approval since every gaming terminal payable requires approval from a regulatory agency. It is obvious that once a player customizes a payable, the payable must undergo regulatory approval (See "Regulation 14"). The Examiner notes that the date on the submitted Regulation 14 is August 2000, however many of the statutes listed under the regulation have dates prior to Applicant's priority date. Furthermore, it is well known to anyone skilled in the art that regulatory approval for gaming machines existed prior to Applicant's priority date. It is obvious that one could gain this approval electronically by transmitting the game related information to a remote computer of a gaming regulatory agency and then having the regulatory agency analyze the game for regulatory compliance and then transmit the approval of the payable information back to the gaming terminal. Transmitting data electronically is well known throughout the art. Furthermore, it is well known throughout the gaming art that the regulatory authority either approves of changes to the gaming machines or fails to

Art Unit: 3713

indicate regulatory compliance. It would also have been obvious for the regulatory authority to suggest modifications that would place the game in compliance with the regulations. It is well known throughout the art that when something is wrong, suggestions on how to correct the situation can be made.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. in view of Van Huben et al. in further view of "Regulation 14" of the Nevada Gaming Statutes. See explanations based on claims 23-25 above.

Claims 1-4 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. in view of Pease et al., U.S. Patent No. 5,326,104. Walker et al. discloses a game apparatus for configuring a payable for a gaming terminal. A microprocessor is used to control game play on the gaming terminal (Fig. 1). An input device is coupled to the microprocessor and receives information from a user for defining at least a part of a first payable (Fig. 3). The gaming terminal receives identification information from a user (col. 4 lines 13-19). The microprocessor is programmed to calculate an overall payout ratio for the payable (col. 7 lines 33-44). An output device such as a display is controlled to output information related to the results of the calculating (Fig. 8). The microprocessor is programmed to store the first payable in a memory coupled to the microprocessor (col. 3 lines 50-59). The input device can be a touch screen device (col. 2 lines 34-35). The display shows information from a stored payable, i.e. the default payable. The information in the stored payable can be modified to define a customized

Art Unit: 3713

paytable, i.e. first payable. The information defines the magnitude of a monetary prize. When a player customizes the magnitude of a monetary prize the player is not allowed to modify or change the prize win frequency.

Consequently, when one parameter is altered, the gaming system compensates by the computer modifying another parameter. Moreover, the microprocessor is programmed to calculate all possible game outcomes and any prizes associated with each possible game outcome (col. 6 lines 57-67; col. 7 lines 1-12). The newly customized payable is then able to be stored in memory (col. 11 lines 14-20).

Pease et al. teaches of a secure automated electronic casino gaming system. In the system a manager, i.e. gaming operator, needs to enter identification information in order to gain access to the paytables of the gaming system. The manager is authorized to change the paytables only after the manager's identification information is received and compared with authorized identities (See Pease et al. col. 26 lines 32-67). Consequently, it would have been obvious at the time the invention was made to only allow authorized individuals such as gaming operators access to changing the paytables of the gaming machines of Walker et al. By only allowing authorized persons access, security is maintained in the gaming machine and regular players can not then distort the paytables to their advantage.

Claims 5-7 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. in view of Pease et al. and in further view of

Art Unit: 3713

Van Huben et al., U.S. Patent No. 5,878,408. Huben lacks in specifically stating that a message is output if the results fail to comply with the gaming criteria. Huben et al. teaches of a data management system and process. In the process a criteria check is performed and any data that does not pass the criteria check fails and a message is sent to the user (See Van Huben et al. col. 51 lines 29-37). It is well known throughout the art to perform criteria checks to determine if data falls within an acceptable range. It would have been obvious at the time the invention was made to compare the customized payable results to predetermined gaming criteria and then output a message to the user if the results fail to comply with the criteria. It is also obvious to suggest a modification to the payable when the results fail to comply with the criteria. For example, in Walker et al. after a user customizes a parameter, calculations to determine all other parameters are performed and the user must approve the new parameters before use. Consequently, if a user inputs an invalid parameter, the calculation section will modify this parameter with a new suggested limit. Moreover, the newly customized payable is prevented from being used until all calculations are performed, thereby gaining regulatory approval and user approval. Since every gaming terminal payable requires approval from a regulatory agency. It is obvious that once a player customizes a payable, the payable must undergo regulatory approval.

***Response to Amendment***

It has been noted that claims 1, 2, 8, 9, 11-15, 21 and 23 have been amended. Claim 20 has been cancelled. New claims 24-26 have been added.

### ***Response to Arguments***

Applicant's arguments filed June 26, 2003 have been fully considered but they are not persuasive.

The Applicant argues that the combination of Pease et al. with Walker et al. teaches away from the concept of claim 1 since in Walker it is the player who modifies the paytables and not a gaming operator. The Examiner acknowledges this fact but notes that Pease clearly illustrates that for security reasons a manager, i.e. gaming operator must input a password to be authorized to change the paytables. Even though in Walker, the player is allowed to modify the paytables, it would have been obvious to one of ordinary skill in the art to utilize the hardware and software components of Walker with an added security feature of only allowing gaming operators access to the game customization. The reference Walker is being used to illustrate that the customization of paytables on a gaming device is well known throughout the art, the fact that a player is the one doing the customization does not alter the fact that the processing, storage, calculation processes are well known. Consequently, the combination of Walker et al. and Pease et al. do not teach away from the Applicant's invention nor are a contradiction in terms when those skilled in the art were considering Walker et al. One skilled in the art

Art Unit: 3713

would certainly look at the hardware and software processes of Walker for altering paytables and not look solely at what type of user was performing the customizations.

The Applicant argues that Van Huben relates to a general data management system and process and does not relate to configuring a payable for a gaming terminal where the criteria compared are gaming criteria. The Examiner acknowledges that the Van Huben reference is broad and general. However, that further indicates that the process of comparing criteria in a computer and outputting messages when certain criteria have not been met is well known throughout the art. Just because Van Huben does not specifically describe comparing gaming criteria doesn't mean that it would not be an obvious feature. Computer processing has consistently had criteria checks throughout various processes. Consequently, any activity that uses a computer can utilize the software features of a criteria check, which certainly includes gaming terminals.

Applicant states that there is nothing to suggest in either Walker or in Van Huben of suggesting a modification for a payable when initial results fail to comply with the criteria. The Examiner agrees that Walker and Van Huben do not mention anything about suggesting a modification, however, it is well known in the art that when one compares things or evaluates criteria, suggestions may be made to help comply with the criteria. The processing of

Art Unit: 3713

helping someone through suggestions has been known for a long time. For example, teaches suggest ways to improve homework or tests to students.

The Applicant argues that there is nothing in Walker or Van Huben relating to regulatory approval by a government. The Examiner notes that the Reference "Regulation 14" has not been included to illustrate that regulatory approval for gaming machines is well known throughout the art. The Applicant further states that they believe this is the first time that a computer of an official regulatory agency is directly connected to a gaming terminal. That may be true, however, it has been well known in the art for some time to connect computers for the transfer of information. Therefore, it is an obvious advancement in the art to connect gaming machines directly with the regulatory authority.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH

Art Unit: 3713

shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K Brockett whose telephone number is 703-308-7306. The examiner can normally be reached on M-Th 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike O'Neill "Acting SPE" can be reached on 703-308-1148. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is 703-306-5648.

JB

JB

July 15, 2003



**MICHAEL O'NEILL  
PRIMARY EXAMINER**